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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,578	10/08/1999	ALIRIO I. GOMEZ	02012-40101	5019

38647	7590	11/09/2004	EXAMINER	

MILBANK, TWEED, HADLEY & MCCLOY LLP
INTERNATIONAL SQUARE BUILDING
1825 EYE STRET, N.W. #1100
WASHINGTON, DC 20006

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/415,578</td><td>Applicant(s)
GOMEZ ET AL.</td></tr>
<tr><td>Examiner
Grigory Gurshman</td><td>Art Unit
2132</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/13/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments, filed on 8/10/2004 and presented an the interview on

10/13/2004, with respect to the rejection(s)of claim(s) 1-23 under 35 U.S.C. 103(a)

have been fully considered and are persuasive. Therefore, the rejection has been

withdrawn. However, upon further consideration, a new ground(s) of rejection is made

in view of U.S. Patent No. 6.289.362 B1 to Van Der Meer.

2.   No amendments of claims 1-23 have been submitted by Applicant.

3.   Referring to the independent claims 1 and 16, Applicant argues that the recitation

"content provider requiring payment for information access" has not been given

patentable weight. Examiner points out that the recitation "content provider requiring

payment for information access" has not been given patentable weight because the

recitation occurs only in the preamble of the independent claim. A preamble is generally

not accorded any patentable weight where it merely recites the purpose of a process or

the intended use of a structure, and where the body of the claim does not depend on

the preamble for completeness but, instead, the process steps or structural limitations

are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and

Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This argument is considered applicable to claim 8, where the "payment" limitation is

recited in the body of the claim. This limitation is addressed in rejections herein.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1- 3, 14 - 20, 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bessette (U.S. Patent No. 6.263.330 B1) in view of Van Der Meer

(U.S. Patent No. 6.289.362 B1).

6.   Referring to the instant claims, Bessette discloses a method and apparatus for the

management of data files (see abstract and Fig. 10). Bessette teaches that client work-

station downloads a record along with the set of pointers, which link the client to the

remotely stored files (see abstract).

7.   Referring to the independent claim 1, the limitation "receiving, by the library

system computer, user identification and password from the user computer" is met by

works-station (client in Fig.10) logging onto a server (300 in Fig.10) using the user

identification and password (see column 10, lines 60-65). The limitation "comparing, by

the library system computer, the received user identification and password with

authorized user identifications and corresponding passwords stored in the library

system to determine whether to grant access to the interactive library system" is met by

a validation table component stored in the memory of the server. Validation table maps

all the registered user IDs to the corresponding passwords. The table is used to validate

clients logging on to the server, for security purposes (see column 10, lines 6-9 and

lines 60-67). The limitation "if comparison results in grant of access, then receiving, by

the library system computer, input from the user computer specifying type of information

desired by the user " is met by a request from the client workstation (304 in Fig. 5) sent

to the library system computer (Server 300 in Fig. 5). Referring to the limitation

"establishing, by the library system computer, telecommunication link with content

provider computer", Bessette shows that the server (library system computer)

establishes the link to the NTSMR database. Bessette, however, does not teach

establishing a telecommunication link with the content provider computer.

8.   Referring to the instant claims, Van Der Meer discloses a method for transferring

annotated universal address (see abstract). Van Der Meer teaches the system

comprising a diary owner system, a diary server and content providers, each coupled to

a computer network (see abstract and Fig.1 and 17). Van Der Meer also shows that the

diary owner system 105 via the browser 142 contacts a content provider 115 to view

content data 130, or more particularly to view the object information 132. If the user of

the diary owner system 105 decides that object information 132 is worthy of adding to

the diary on the diary server 120, the user may provide an indication of interest to a

request interface, e.g., by performing a mouse-down event while the mouse pointer is

over a virtual button on the web page provided by the content provider 115. Accordingly,

the content provider 115 transfers the AUAs 134 corresponding to the user's selection

to the diary server 120. Since an applet is limited to setting up a communications link

with only the originator of the applet, it will be appreciated that transferring the AUA 134

to the diary server 120 may include a level of indirection. That is, the content provider

115 via the CP server 129 may forward a transfer script 136 to the browser 142 on the

diary owner system 105. The browser 142 executes the transfer script 136, which

generates a request (e.g., a post request) for the diary server 120 to download a

transfer applet 151. It will be appreciated that the request may be implemented by

generating a web page containing the request. The transfer applet 151 can establish a

communications link with the diary server 120 (for storage of the new AUAs, e.g., as

part of a storage operation of the full user diary data 146) and can establish a

communications link with the diary applet 148 on the diary owner system 105 to point

out the newly added AUAs 156 (for immediate presentation at the diary owner system

105) – see Fig.1.

9.   Therefore, at the time the invention was made, it would have been obvious to one

of ordinary skill in the art to receive by the server of Besset an input from the user and

establish the telecommunication link with the content provider computer (i.e. Web

server) as taught in Van Der Meer. One of ordinary skill in the art would have been

motivated to receive by the server an input from the user and establish the

telecommunication link with the content provider as taught in Van Der Meer for

controlling the aspects of the objects from within the user's diary (see Van Der Meer

abstract and Fig.17).

Referring to the limitation "receiving, by the library system computer, result of the

search request from the content provider computer; and providing, by the library system

computer, the result to the user computer", Besset shows the server (300 in Fig. 10)

receiving the query result from the NDSMR database and returning the NDSMRs (25 in

Fig. 10 and 908 in Fig. 9) to workstation (client in Fig. 10). Besset, however, does not

explicitly teach that the result of the search request is returned to the library computer

and then forwarded to the user. Van Der Meer shows (see Figs.1 and 17) the diary

server (i.e. library system), which receives information form the content server and

transfers applet to the user. Therefore at the time the invention was made, it would have

been obvious to one of ordinary skill in the art to modify the server receiving the search

result form the data base of Basset by having the content provider sending the

information to the Diary server (i.e. library system) and then having the server send the

applet to the user as taught in Van Der Meer. One of ordinary skill in the art would have

been motivated to modify the server receiving the search result form the data base of

Basset by having the content provider sending the information to the Diary server (i.e.

library system) and then having the server send the applet to the user as taught in Van

Der Meer for maintaining the annotated addresses and presentation context information

for subsequent retrieval (see Van Der Meer, abstract).

10.   Referring to the independent claim 16, the limitation "a storage unit electrically

coupled to the library computer to store user identifications and passwords" is met by

the validation table which maps all the registered user IDs to the corresponding

passwords (see Besset, column 10, lines 6-9 and lines 60-67). The limitation " the

program comparing user identification and password received from the user computer

with the user identifications and corresponding passwords stored in the second storage

unit" is met by the validation functional block (see Besset, column 10, lines 57-64).

11.   Referring to claim 2, 19, Besset teaches that a doctor (i.e. user of the work-
station) can use the pointers in order to choose the type and the way the of displaying of
the information (see column 7, lines 52-56), which meets the limitation "customizing
user interface ... based on type of information desired by the user".

12.   Referring to claims 14 and 15, it is well known in the art to notify the user upon
receiving the results of a search request by means of electronic communications. For
example various data base applications use the e-mail alerts to the users.

13.   Claims 4 -13, 21 and 22 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Bessette (U.S. Patent No. 6.263.330 B1) in view of Van Der Meer
(U.S. Patent No. 6.289.362 B1) and further in view of Usui (U.S. Patent No. 5.956.697).

14.   Referring to the instant claims Bessette and Van Der Meer the library system
computer receiving the search results from the content provider. Bessete and Van Der
Meer, however do not teach determining the time amount of access, recording it and
generating an account statement. Usui discloses a timer-based fee-charging system for
internet (see abstract and Fig.1). Usui teaches calculating access charges according to
the amount of access time used by each client (i.e. user) – see column 3, lines 1-6.
Therefore, at the time the invention was made, it would have been obvious to one of
ordinary skill in the art to have the library system computer receiving the search results
from the content provider of Bessette and Van Der Meer and calculate access charges
(i.e. account statement) according to the amount of time used by each user as taught in
Usui. One of ordinary skill in the art would have been motivated to have the library

system computer receiving the search results from the content provider and calculate

access charges (i.e. account statement) according to the amount of time used by each

user as taught in Usui for charging the user for the access time (see Usui, abstract).
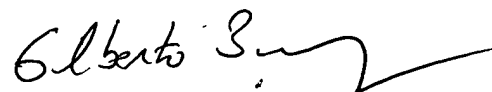

Conclusion

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Grigory Gurshman whose telephone number is

(571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Grigory Gurshman
Examiner
Art Unit 2132

GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100